

criticism of the specification in this case can be availed of to deprive complainant of any part of the patentee's actual invention; and, second, it is plain that the respondent's machine was built up on the complainant's machine, and is the result of a studied effort to secure its essential advantages. The respondent has so arranged the various parts which he claims vary from the complainant's elements that the substitution of one size of pulley for another can be made by the respondent with no disturbance of any other part of the machine. By slightly varying the shaft carrying the respondent's pulley, pulleys of various dimensions might at once be attached to it, and the complainant's precise construction would be the result. We do not think the patent can be lawfully evaded, as the respondent has attempted it. The respondent's set of several pulleys of differing diameters is only complainant's cone pulley divided into sections through its axis; and the fact that the set of several pulleys differs, in that it is more cumbersome, and involves delays, is only an ordinary feature of colorable infringements, which are characterized by a mere imitative capacity, without the spirit of invention. The respondent's machine has in it the essence of Grosselin's invention, and we must hold that it infringes.

Another point of importance remains to be considered. The preamble of the complainant's patent contains a recital of several foreign patents which were taken out for the same invention. This recital is erroneous in several particulars, but the record fails to show that there was any intentional misrepresentation. So far as we can discover, the requirement of a reference to foreign patents in the preamble of an application is a mere regulation of the patent office, which is so far reasonable that it may bar the issue of a patent until it is complied with, but which cannot invalidate a patent once issued unless perhaps when the recital is erroneous through a willful misrepresentation or some fraudulent purpose. Rev. St. §§ 4887-4892. But the French patent No. 141,170, issued February 16, 1881, to Grosselin Pere et Fils, expiring 16 years from its date, is for the same invention as that now in issue. Grosselin Pere et Fils are, for all practical purposes, the same as the patentee in the case at bar. Therefore the patent in suit expired after this appeal was taken, and no injunction can now issue. The decree of the circuit court is reversed, with costs, and the case remanded to that court, with directions to enter a decree for an accounting, but to deny an injunction, on the ground that the patent expired after the appeal was taken.

NEW YORK FILTER MANUF'G CO. v. ELMIRA WATERWORKS CO. et al.

(Circuit Court, N. D. New York. September 20, 1897.)

PATENTS—INFRINGEMENT—METHOD OF FILTRATION.

The Hyatt patent, No. 293,740, for an improved method of clarifying water by introducing into it a coagulant simultaneously with its passage through the filter, thereby avoiding the use of the settling basins of the prior art, and making the process continuous, *held* infringed by a process in which cisterns or tanks were introduced, through which the water passed

with a continuous flow in eddying currents, and which, therefore, were not the settling basins of the prior art.

This was a suit in equity by the New York Filter Manufacturing Company against the Elmira Waterworks Company and others for alleged infringement of letters patent No. 293,740, issued February 19, 1884, to Isaiah S. Hyatt, for an improved method of clarifying water. In a suit heretofore brought by the complainant against Schwarzwald and Fink in the circuit court for the Southern district of New York, this patent was sustained on final hearing, and a decree entered for an injunction and an account (61 Fed. 840), which decree was affirmed by the circuit court of appeals for the Second circuit in January, 1895 (13 C. C. A. 380, 66 Fed. 152). Subsequently a suit was brought by the complainant against the Niagara Falls Waterworks Company for infringement of the same patent, which resulted in a decree for a preliminary injunction (77 Fed. 900), which decree was affirmed by the circuit court of appeals (80 Fed. 924).

John R. Bennett, M. H. Phelps, and F. G. Fincke, for complainant.
Frederic H. Betts, for defendants.

COXE, District Judge. I have examined with care all of the testimony relating to the only question now open—the question of infringement. In view of what has been said heretofore by this court and the circuit court of appeals it will serve no useful purpose to discuss this question at length. Suffice it to say that, in my judgment, the Elmira plant infringes the Hyatt patent. The defendants seem to entertain the opinion that they may use the Hyatt process if they use something else in connection with it. I do not think so. The real work of purification at Elmira is done by the Hyatt process. The cisterns underneath the filters may or may not be an improvement, but the filters act in precisely the same manner as those which have already been condemned by the courts. The tanks are larger than in the Niagara Case and the sedimentation is greater, but the difference is one of degree only. If a tank, through which a continuous flow of water passes in eddying currents, can become a “settling basin” the Niagara tanks are within this category as fully as those at Elmira. Tanks of this type are not the settling basins of the prior art to which the appellate court alluded in the closing sentence of its opinion.

It would have been better for the complainant if the court had voided the patent in limine rather than place a construction upon it which enables any one to infringe who has wit enough to pass the water on its way to the filter through a cistern where some of the impurities are caught. Upon the theory of the defendants, water of precisely the same degree of purity might be passed to the filter bed from two distinct sources; if conducted there direct it would be an infringement, but if passed through a tank, where the coarser impurities are caught, it would not be. In each instance the water actually filtered contains the same amount of impurities, but in the latter it is found more convenient, owing to its greater turbidity, to arrest some of the coarser impurities before introducing it to the filter bed. In both cases the Hyatt process is used.

It is due to the defendants, I think, in order to avoid further misunderstanding, to say that, in my opinion, they cannot evade the patent upon their present theory. Even though they should increase still further the capacity of the cisterns through which they pass the flowing stream it would not avail them.

The test at Elmira has been severely criticised by the complainant as unfair and misleading chiefly because lime was used and also an unusually large amount of alum. There certainly is foundation for complainant's contention that the plant could not, with good results, be operated practically as it was experimentally. Assume, however, the test to be fair, I am of the opinion that the results obtained fail to show that the defendants' cisterns are settling basins in the sense so frequently alluded to. The motion is granted.

THOMSON-HOUSTON ELECTRIC CO. v. HOOSICK RY. CO.

(Circuit Court of Appeals, Second Circuit. July 21, 1897.)

1. APPEALS IN PATENT CASES—PRELIMINARY INJUNCTION—SCOPE OF REVIEW.

On appeal from an order granting a preliminary injunction in a patent case, where the court below bases its action entirely upon a prior decision in another circuit, sustaining the patent, the circuit court of appeals is not itself constrained to adopt the rulings of such other circuit court, but is at liberty to re-examine the same, and dispose of the questions of law conformably to its own convictions, giving to the former adjudication only such weight as, in its own judgment, the same is entitled to.

2. PATENTS—VALIDITY—PRIOR PATENT FOR SAME INVENTION—TROLLEY RAILWAYS.

The Van Depoele patent, No. 495,443, for a "traveling contact for electric railways," examined, and compared with the prior patent No. 424,695, to the same inventor, and *held* to be for the same invention covered by that patent so far as concerns the claims which relate to the combinations between the contact device and the suspended conductor and to the structural features of the contact device, and the later patent therefore *held* invalid as to claims 6, 7, 8, 12, and 16.

Appeal from the Circuit Court of the United States for the Northern District of New York.

This was a suit in equity by the Thomson-Houston Electric Company against the Hoosick Railway Company for alleged infringement of a patent for traveling contacts for electric railways. The circuit court entered an order granting a preliminary injunction, and the defendant has appealed.

Charles E. Mitchell, William C. Witter, and Robert N. Kenyon (Henry B. Brownell, of counsel), for appellant.

Betts, Hyde & Betts, for appellee.

Before WALLACE, LACOMBE, and SHIPMAN, Circuit Judges.

WALLACE, Circuit Judge. This is an appeal from an order granting a preliminary injunction restraining the defendant from making, using, or vending the apparatus specified in claims 6, 7, 8, 12, and 16 of letters patent No. 495,443, granted April 11, 1893, to the administrators of Charles J. Van Depoele, assignors to the complainant, for